REMARKS

In the Office Action, the Examiner noted that Claims 1-130 are pending in the application, and that Claims 1-20, 40-127 and 129 are withdrawn from consideration. In addition, the Examiner noted that Claims 21-39, 128 and 130 are rejected. By this Amendment, Claims 1-20, 40-127 and 129 have been canceled. This, Claims 21-39, 128 and 130 are pending in the application. The Examiner's rejections are traversed below.

Rejection under 35 USC § 112, Second Paragraph

Claim 31 stands rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended Claim 31 to remove the noted informality. The Applicant is not of the opinion that the amendment of Claim 31 is a narrowing amendment. Accordingly, Applicant respectfully submits that Claim 31 satisfies the requirements under 35 USC § 112, Second Paragraph. Withdrawal of this rejection is respectfully requested.

Rejection under 35 USC § 101

Claims 21, 128 and 130 are rejected under 35 USC §101 as not being tied to any technological art. Applicant has clarified that the method of the present invention as recited, for example, in Claims 21, 128 and 130, are directed to a computer implemented process. Accordingly, the Applicant disagrees that Claims 21, 128 and 130 are not statutory subject matter. In addition, the Examiner's citation of a non-precedential Board of Patent Appeals and Interference Decision, i.e., ex-parte Bowman, is not appreciated. Accordingly, Applicant

respectfully submits that in fact Claims 21, 128 and 130 are directed to statutory subject matter. Withdrawal of this rejection as respectfully requested.

With respect to dependent claims 22, 23, 25, 26, 29-37 and 39, Applicant cannot tell whether the Examiner has in fact rejected these claims.

Rejection under 35 USC § 103

Claims 21-39, 128 and 130 stand rejected under 35 USC §103 as being unpatentable over Fox, US Patent 5,132,899. Applicant respectfully traverses this rejection.

Fox, described in detail in the present application on pages 2-3, discloses a stock and cash portfolio development system. As disclosed in Figure 1 of Fox, the system of Fox uses data gathering and processing methodology to produce a system where a list of stocks and a cash position is generated and purchased for investment and operating accounts. Specifically, the Fox system integrates three areas of data: investment performance for investment managers; federal securities and exchange commission reports filed quarterly by investment managers; and financial characteristics for a number of stocks, to produce a stock portfolio.

Fox is lacking in many of the features of the present invention. For example, the present invention, in at least one embodiment, provides a system, method, and/or computer readable medium containing instructions usable not only for providing raw information and data but also usable for evaluating performance based on returns observed after decisions concerning buying and selling activity, historical consistency at picking entry and exit points and/or the number of buying or selling decisions made by the insider or investing entity. Further, the present invention in at least one embodiment provides a system, method, and/or computer readable medium usable

for not only evaluating performance with respect to all insiders and/or traders, but also usable for evaluating performance with respect to insiders and/or traders in a particular industry.

Additional differentiators between the present invention over Fox include the ability to evaluate or score an insiders or traders actions. Fox fails to disclose all of the above features. In particular, Fox generates a list of stocks and cash position which is purchased for investment and operating accounts. (Column 1, lines 64-68). Fox does not determine the list of stocks and cash position for investment based on trades but merely selects managers that have essentially selected the best stocks over an extended period of time. (Column 4, lines 24-30). Thus, Fox only considers an overall performance of an investment manager that invests in a collection of stocks and rates those investment managers in order of performance based on a standard rate of return formula. (Column 4, lines 33-45). This standard rate of return formula is based on the 1968 Banking Administration Institute study. (Column 4, lines 49-50).

In contrast, the present invention produces a rank list of investors according to an evaluation of the investor's performance relating to, for example, at least one transaction made by the investors involving investments, as recited, in independent Claim 21. Independent Claim 21 further recites the combination of elements including "retrieving list of investors," "generating an evaluation list by removing investors failing to meet predetermined criteria," and "calculating a performance score for each investor." As recited in independent Claim 21, the performance score is "indicative of the investors performance by considering an average historical performance of an investment following a transaction by the investor, historical consistency of the investors performances with respect to transactions involving at least one investment and the number of transactions made by the investor." Independent Claim 21 further

recites in combination "calculating, for each investor using said performance scores, a final transaction score indicative of the investors relative performance with respect to all investors on said evaluation list."

As discussed above, Fox does not show or suggest the combination of features recited in independent Claim 21. Withdrawal of this rejection is respectfully requested. In addition, the present invention provides benefits, which are not provided for by Fox. For example, the present invention is able to provide information pertaining to the reliability of a particular insider's or trader's actions. Further, the present invention is able to optionally evaluate performance with respect to insiders and traders for specific industries. Because as described above Fox does not show or suggest the combination of elements recited in Claim 21, Fox is unable to provide these corresponding benefits. Thus, for these reasons as well, Applicant respectfully submits that the combination of limitations recited in independent Claim 21 patentably distinguishes over Fox. Withdrawal of this rejection is respectfully requested.

The Examiner admits that Fox does not teach the step wherein the performance score considers the number of transactions made by the investor. Office Action page 4. The Examiner however relies on an official notice that the performance score considers the number of transactions made by the investor is old and well known in the art. The Examiner alleges that the rate of return is based on all transactions made during the period under consideration. The Applicant completely disagrees with the Examiner, and completely disagrees with the Examiner's official notice. Specifically, the transaction cost may be a function of a number of specific trades made for the same security versus a number of different securities, or the transaction cost can be almost nothing if the investment manager in Fox never sells any

securities that they have previously purchased, or the transaction cost can be considered a fixed cost of doing business with respect to the securities because it is generally the same percentage no matter what securities is sold. In addition, many companies do not charge investors for specific trades, but only charge based on a yearly subscriber fee to a portfolio of funds. Therefore, while the cost of a specific transaction may affect the overall return of an investment manager in the aggregate, the specific transaction cost is not believed to be considered in determining the specific performance of an investment manager under the Fox stock and cash portfolio development system. Accordingly, the Applicant rejects the Examiner's official notice in this regard, and respectfully requests the Examiner to provide a prior art reference which relates to the invention being claimed in independent Claim 21, or provide an affidavit under 37 CFR §1.104(d)(2) to support the official notice, or withdraw the rejection.

With respect to the rejection of Claims 22-31 and 38, the Examiner states that these steps are either disclosed in Fox (without citing where in Fox these steps may be disclosed) or are well known in the art. Applicant respectfully disagrees with the Examiner, and therefore, asks the Examiner to provide an affidavit detailing why these features in the claims are well known in the art, a prior art reference which actually shows these features or withdraw the rejection.

With respect to the rejection of Claims 32-37 and 39, the Examiner admits that Fox does not explicitly disclose the steps of calculating the specific performance scores and related statistics listed in these claims. However, the Examiner states again that these statistics are well known. Applicant cannot more strongly disagree with the Examiner since Applicant created these new steps of determining performance scores, and therefore, these scores are not well known in the art. Again, Applicant requests that Examiner to provide an affidavit supporting this

rejection or prior art reference that actually recites these features, or withdraw the rejection. Applicant does not at all understand the Examiner's statement "the combination of disclosures taken as a whole" on page 5 of the Office Action particularly because there's only one disclosure, i.e., Fox, which does not even show the features of the invention as claimed in Claims 32-37 and 39.

Accordingly, Applicant respectfully submits that Claims 21-39, 128 and 130 patentably distinguish over Fox. Withdrawal of this rejection is respectfully requested.

In addition, Applicant is extremely disturbed with respect to the Examiner's taking of official notice under the particular factual situation of the present application. Specifically, the February 21, 2002 procedures for relying on facts which are not of record as common knowledge issued by Mr. Kunin, specifically states that, "it would not be appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well known." This is the very case in the present application. Particularly, the official notice or common knowledge asserted by the Examiner is not in fact well known in connection with the method of the presently claimed invention, and in general, in connection with the present invention. Accordingly, Applicant requests the Examiner support the official notice or common knowledge alleged by the Examiner with adequate evidence. Thus, for these reasons as well, Applicant respectfully submits that the present invention patently distinguishes over Fox. Withdrawal of this rejection is respectfully requested.

CONCLUSION

Applicant respectfully submits that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicant does not concede that the cited prior art shows any of the elements recited in the claims. However, Applicant has provided specific examples of elements in the claims that are clearly not present in the cited prior art.

Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant is providing examples of why the claims described above are distinguishable over the cited prior art.

Applicant wishes to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicant reserves the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicant's best attempt at providing one or more definitions of what the Applicant believes to be suitable patent protection. In addition, the present claims provide the

intended scope of protection that Applicant is seeking for this application. Therefore, no estoppel should be presumed, and Applicant's claims are intended to include a scope of protection under the Doctrine of Equivalents.

For all the reasons advanced above, Applicant respectfully submits that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicant respectfully submits that the Application is in condition for allowance, and that such action is earnestly solicited.

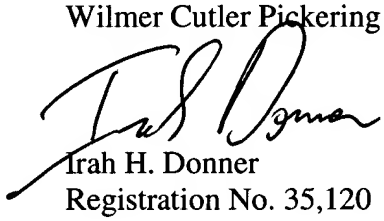
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

Wilmer Cutler Pickering Hale and Dorr LLP



Irah H. Donner
Registration No. 35,120

1455 Pennsylvania Ave., NW
Washington, DC 20004
TEL 202.942.8585
FAX 202.942.8484
Date: 6/1/04
IHD:cj: 26119-100 US1